

Appl. No. 10/027,987  
Amdt. dated Sept. 10, 2003  
Reply to Office action of June 10, 2003

### **REMARKS/ARGUMENTS**

Claims 1-33 remain in the application.

The examiner rejected claims 1-33.

It is believed that no fees are due at this time. In view of the following remarks and amendments, applicants respectfully requests a timely Notice of Allowance be issued in this case.

#### ***Objections to the Drawings***

The examiner objected to the drawings under 37 C.F.R. 1.83(a) because the drawings do not show every feature of the invention specified in claims 2, 3, 8, 12 and 14. Applicants respectfully submit the proposed drawing correction to Figs. 1-5, which shows the cross sectional difference in duct 40 in Fig. 2 (claim 2), identifies the intermediate duct as reference numeral 46 in Figs. 3 and 5 (claim 3), identifies the air focusing device 56 in Figs. 1 and 4 (claim 8), shows the vibration dampener 32 in Fig. 1 (claim 12), and shows the processor 34 in Figs. 1-5 (claim 14). These corrections are supported in the drawings and original specification. Accordingly, applicants respectfully submit that no new matter is added and claims 2, 3, 8, 12 and 14 are supported by the corrected drawings. Applicants respectfully submit that the proposed drawing correction overcomes the examiner's objection.

In addition, the examiner objected to the drawings because "the figures are not clear as to differentiate between what is considered an intermediate duct and the first and second end." Applicants respectfully submit the proposed drawing correction to Figs. 3 and 5, which identifies the already shown intermediate duct as reference numeral 46. This correction is supported in the drawing and original specification. Accordingly, applicants respectfully submit that no new matter is added and claims 3 and 20 are supported by the corrected drawings. Applicants respectfully submit that the proposed drawing correction overcomes the examiner's objection.

#### ***Rejections under 35 U.S.C. § 112***

The examiner rejected claims 1-33 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification. Applicants respectfully submit that specification sufficiently describes the conversion of wind power to electricity. Specifically, the specification states that "[w]ind turbines of this type are well known to those of ordinary skill in the art and may also be referred to as wind generators or wind turbine/generators." (page 6, paragraph 13, lines 5-6). In addition, the specification refers to the conversion of wind power to electricity. (page 8, paragraph 17, lines 1-3; page 6, paragraph 19, lines 18-20). While Applicants acknowledge that a wind turbine, as that term is often used, does not actually generate the electricity alone, one of

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ordinary skill in the art would certainly understand the specification and drawings to mean that the wind turbine also includes the requisite generator to produce electricity. Thus, Applicant traverses this rejection and reconsideration is respectfully requested in light of the view that it is well known that wind turbines are capable of being used to generate electricity. Applicants, therefore, submit that claims 1-33 are allowable under 35 U.S.C. § 112, first paragraph. Accordingly, applicants respectfully requests that the rejection of claims 1-33, as amended, be withdrawn.

The examiner also rejected claims 1-33 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. Applicants respectfully submit that the foregoing amendments to the specification, Figs. 1-5 and claims 1-33 overcome the examiner's rejection. Applicants, therefore, submit that claims 1-33 are allowable under 35 U.S.C. § 112, second paragraph. Accordingly, applicants respectfully request that the rejection of claims 1-33, as amended, be withdrawn

***Rejections under 35 U.S.C. § 103(a)***

The examiner rejected claims 1, 3, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,394,016 (hereinafter referred to as "Hickey") in view of U.S. Patent No. 4,651,805 (hereinafter referred to as "Bergeron, Jr."). The examiner rejected claims 4, 5, 7, 9, 10, 15, 16, 18, 20-22, 24, 26, 27 and 29-32 under 35 U.S.C. § 103(a) as being unpatentable over Hickey in view of Bergeron, Jr. and U.S. Patent No. 6,319,115 (hereinafter referred to as "Shingaki"). The examiner rejected claims 2, 8, 19 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Bergeron, Jr., and Shingaki as applied to claims 1 and 18 and further in view of U.S. Patent No. 4,012,163 (hereinafter referred to as "Baumgartner et al."). The examiner rejected claims 6, 11 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Bergeron, Jr., and Shingaki as applied to claims 1 and 18 and further in view of U.S. Patent No. 6,437,457 (hereinafter referred to as "Roskey"). The examiner rejected claims 17 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Bergeron, Jr., and Shingaki as applied to claims 1 and 18 and further in view of U.S. Patent No. 4,421,967 (hereinafter referred to as "Birgel").

In order to establish a prima facie case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, (2) there must be a reasonable expectation of success, and (3) the prior art or combined references must teach or suggest all the claim limitations. MPEP § 2143; *In re Vacek*, 947 F.2d 488 (Fed. Cir. 1991). "The prior art must suggest the desirability of the claimed invention." MPEP § 2143.01. **Both the invention and the prior art references must be considered as a whole.** MPEP § 2141.02. Applicant respectfully submits that claims 1-33, as amended, are not obvious over the cited art and therefore allowable under 35 U.S.C. § 103(a) for the reasons stated below.

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***There is no teaching or suggestion in the prior art to modify the reference as proposed.***

Obviousness can only be found where there is some teaching, suggestion, or motivation to modify a reference in the manner proposed, found either in the prior art itself or in the knowledge generally available in the art. See MPEP § 2143.01; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). In addition, obviousness can only be found under a combination of references where there is some teaching, suggestion, or motivation to do so, found either in the references themselves or in the knowledge generally available in the art. See MPEP § 2143.01; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). Further, the mere fact that references can be combined or modified does not necessarily make the combination obvious unless the prior art suggests the combination. See MPEP § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Finally, simply stating that a claimed modification of the prior art would have been "obvious to a person of ordinary skill in the art at the time the invention was made" because all aspects of the claimed invention were individually known in the art is not enough to establish a prima facie case of obviousness without some objective reason to combine the teachings. MPEP § 2143.01; *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

With respect to Hickey, the examiner stated that "two or more air ducts 154 are disclosed so that wind may enter the building (see figure 9)." The examiner later repeatedly stated that "Hickey does not disclose explicitly having a plurality of ducts and intermediate ducts." In actuality, the relevant portion of Hickey states:

The exterior of the building 152 is provided with one or more openings 154 which allows wind to enter the region 150 between floors 142 and 144 from either direction indicated generally by arrow 156, parallel to the longitudinal axis of the auger shaped, fluid medium engaging member and electrical generating system 148.

(col. 9, lines 8-13). Although Hickey refers to one or more openings, applicants respectfully submit that only two openings are disclosed (an inlet and an exhaust, both of which are labeled as 154 in figure 9). As shown, the wind can only be passing in one direction through region 150. As a result, only one inlet and one exhaust opening are disclosed. But, even if Hickey disclosed more than one inlet, there is no reference to the use of ducts to funnel air to the engaging member. Moreover, there is no teaching or suggestion in Hickey to use two or more ducts to funnel air to the engaging member. Such a modification would be unnecessary since Hickey's invention is designed to be installed in the space between floors of a skyscraper. In fact, Hickey uses a deflector 164, rather than ducts, to direct air to the engaging member. (col. 9, lines 19-35). Applicants, therefore, respectfully submit that claims 1-33, as amended, are not obvious over the cited art and are allowable under 35 U.S.C. § 103(a).

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With respect to Bergeron, Jr., the examiner stated that this reference "discloses for the purpose of providing an efficient air circulation system for a building, air intakes 22 and a building having a plurality of intake ducts, exhaust ducts and intermediate ducts (see figure 1, 3, 5, 6, 9, 14 and 15)." Applicants respectfully submit that there is no teaching or suggestion in Bergeron, Jr. to cure the previously described deficiencies of Hickey. Specifically, Bergeron, Jr. relates to a heat transfer system. The examiner referred to it as an air circulation system. In either case, Bergeron, Jr. is an air distribution system. Claims 1-33 recite multiple ducts for use as a collection system to funnel more air to the wind turbine. Applicants respectfully submit that there is no teaching or suggestion to use the teachings of an air distribution system to cure the deficiencies of Hickey. Applicants, therefore, respectfully submit that claims 1-33, as amended, are not obvious over the cited art and are allowable under 35 U.S.C. § 103(a).

With respect to Shingaki, the examiner stated that this reference "discloses for the purpose of reducing dew condensation by improving air circulation within a building, an air intake 72 mounted on an exterior of the building (see figure 1)." Just as with Bergeron, Jr., Applicants respectfully submit that there is no teaching or suggestion to use the teachings of the air circulation and dew condensation system of Shingaki to cure the deficiencies of Hickey. Applicants, therefore, respectfully submit that claims 1-33, as amended, are not obvious over the cited art and are allowable under 35 U.S.C. § 103(a).

With respect to Roskey, the examiner stated that this reference "discloses for the purpose of providing a ventilation system that is fuel efficient, air scoop 104 (see figure 13), which can change the position." Note that the Roskey air scoop 104 is used as an exhaust, not as an inlet. Just as with Bergeron, Jr. and Shingaki, Applicants respectfully submit that there is no teaching or suggestion to use the teachings of the air ventilation system of Roskey to cure the deficiencies of Hickey. Applicants, therefore, respectfully submit that claims 1-33, as amended, are not obvious over the cited art and are allowable under 35 U.S.C. § 103(a).

***There is no expectation of success.***

In order to establish a prima facie case of obviousness based on a combination of references, there must be a reasonable expectation of success. For the reasons stated above, Applicant respectfully submits that a person of ordinary skill in the art would have no reasonable expectation of success to modify Hickey or to combine the teachings of Hickey, Bergeron, Jr., Shingaki and Roskey to cure the deficiencies of Hickey. Applicants, therefore, respectfully submit that claims 1-33, as amended, are not obvious over the cited art and are therefore allowable under 35 U.S.C. § 103(a).

***The cited art does not teach or suggest all the claim elements.***

Unless the reference(s) teach or suggest all the claim limitations, obviousness cannot be found. MPEP § 2143.03. Further, once an independent claim is found to be

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non-obvious under 35 U.S.C. § 103, then any claim which depends from that independent claim is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). For the reasons stated below, Applicants respectfully submit that the cited references and common knowledge do not disclose, teach or suggest all the claim elements of claims 1-33, as amended.

#### ***Claims 1 and 18***

With respect to claims 1 and 18, as amended, Applicants respectfully submit that the cited references do not disclose, teach or suggest:

two or more air ducts within an enclosure of the building, each air duct having a first end connected to an air duct intake device mounted on the building in a non-axial relationship to the wind turbine and a second end connected to the wind turbine air intake, the air ducts funneling the wind to the air intake of the wind turbine.

As discussed above, the examiner's combination of Hickey, Bergeron, Jr., Shingaki and Roskey does not disclose, teach or suggest two or more air ducts within an enclosure of the building in a non-axial relationship to the wind turbine to funnel the wind to the air intake of the wind turbine. As a result, Applicants respectfully submit that claims 1 and 18, as amended, are not obvious over the cited art and are, therefore, allowable under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the rejection of claims 1 and 18, as amended, be withdrawn.

#### ***Claims 2-17 and 19-33***

Applicants respectfully submit that claims 2-17 and 19-33 depend from claims 1 and 18, respectively, which are allowable for the reasons stated above, and further distinguish over the cited references. Claims 2-17 and 19-33 are therefore allowable under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the rejection of claims 2-17 and 19-33 be withdrawn.

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**Conclusion**

For the reasons set forth above, applicants respectfully request reconsideration by the examiner and withdrawal of the rejections. Applicants submit that claims 1-33, as amended, are fully patentable. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

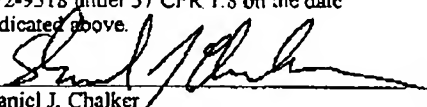
Respectfully submitted,

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I certify that this paper is being transmitted via facsimile to Technology Center 2800 at (703) 872-9318 under 37 CFR 1.8 on the date indicated above.
 Daniel J. Chalker